

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1 and 4-11 are pending.

Claims 7 and 10-11 were rejected as allegedly being “anticipated” by the disclosure of Inoue et al. (U.S. Patent 5,743,971).

Applicants submit it is highly doubtful that (A) an oxidative substance, (B) a silicate and/or silicon dioxide, and (C) at least one metal cation selected from the group consisting of Ti, Zr, Ce, Sr, V, W and Mo and oxymetal anions and fluorometal anions thereof would indeed react under the conditions of a reaction time of 5 to 180 seconds and a reaction temperature of 20 to 50°C as disclosed by Inoue. Inoue is deficient and appears to be inoperative for the alleged “teaching” relied upon by the examiner. Therefore, Inoue does not provide a clear disclosure for producing Applicants’ claimed gasket material comprising a metal plate and a film.

For the above stated reasons, it is respectfully submitted that the reasoning underlying the anticipation rejection made in item 2 of the Official Action does not bear up to thorough scrutiny. Therefore, this rejection should be withdrawn and claims 7 and 10-11 should be allowed.

Claims 1, 4-6 and 8-9 were rejected as allegedly being “obvious” over the disclosures of Inoue et al. (U.S. Patent 5,743,971) in view of Teranishi et al. (U.S. Patent 6,502,830).

Under the Response to Arguments, item 5 of the Office Action, the examiner states that [0192] of Matsuzaki et al. (U.S. Publication 2003/0072962) provides evidence that a reaction will take place in Inoue. At the outset, counsel notes that the examiner relies upon a reference not included in the references cited and applied in the Office Action. One would think that a reference relied upon should be included within those specifically cited as grounds for the rejection. However, even if it is a so-called “teaching” reference, it is still not pertinent to the claimed subject matter as it is antithetical to the teachings of the primary reference Inoue.

[0192] of Matsuzaki actually discloses that a film-forming organic resin and a compound containing activated hydrogen are reacted under conditions of a reaction time of 1 to 8 **hours** and reaction temperatures of 10 to 300°C. This does not provide evidence that Inoue's (A) oxidative substance, (B) silicate and/or silicon dioxide, and (C) at least one metal cation selected from the group consisting of Ti, Zr, Ce, Sr, V, W and Mo and oxymetal anions and fluorometal anions thereof will react under conditions of a reaction time of 1 to 8 hours and a reaction temperature of 10 to 300°C. The reason for this is because the objects are different as between Matsuzaki and Inoue and such different objects is evidence that the two disclosures cannot be combined. Matsuzaki is not predictive of the results which are obtained following Inoue's disclosure, and the latter's reaction product would not form under the conditions disclosed.

According to [0192] of Matsuzaki, the differences between the references is also shown by Matsuzaki's reaction time of 1 to 8 hours. In contrast, Inoue's reaction can take place in 5 to 180 **seconds** and has a preferred temperature of only 20 to 50°C. Clearly, Inoue's reaction to place a rust proof film on a metal substrate is much faster than Matsuzaki's reaction. Therefore, it is apparent that using Inoue's time in which the operation which is completed in only 5 to 180 sec will not provide the conditions necessary to form the reaction product defined in applicants' claims.

In order to properly rely on the information contained in the Matsuzaki reference it is necessary to take into account the information included in the primary reference as well. As the two documents are so divergent as to reaction conditions, in particular time, it is not seen that a person having ordinary skill in the art would consult Matsuzaki as a means or a guidance for interpreting the Inoue reference.

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For the above stated reasons, it is respectfully submitted that the reasoning underlying the obviousness rejection made in item 4 of the Official Action does not bear up to thorough scrutiny. Therefore, this rejection should be withdrawn and claims 1, 4-6 and 8-9 should be allowed.

Reconsideration and favorable action are solicited.

Respectfully submitted,

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